

Application No.: 10/593,039

Attorney Docket No.: 69409.001017
Response to 6/16/10 NFOA**REMARKS**

This Amendment is filed in response to the Office Action dated June 16, 2010 (the "Office Action").

STATUS OF THE CLAIMS

Claims 1-18 were pending at the date of the Office Action, and all claims stand rejected.

PRIOR ART REJECTIONS

The present Office Action maintains the earlier-applied claim rejections without substantive change. In general, the Office Action rejects the claims under 35 U.S.C. § 103 in view of Parker (U.S. Pat. No. 7,013,528) in combination with Delgado (U.S. Pat. No. 6,021,545).

The Applicant previously explained how the prior art references teach against the cited combination of art. In those explanations, the Applicant pointed to specific technical problems that would arise from the proposed combinations, as well as other disclosures in those references that indicate that the proposed combinations would be contrary to the purpose of the prior art and render the prior art unsatisfactory for its intended purpose.

The latest Office Action reaffirming the earlier rejections fail to address the substance of the Applicant's earlier observations, and relies on legally-erroneous principles to maintain the rejections.

Prior Art References Must Be Considered As A Whole

It is well-established that "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); *see also*, M.P.E.P. § 2141.03. Furthermore, where prior art references teach away from a combination or render the prior art unsatisfactory for its intended purpose, the combination of references is not proper. *See* M.P.E.P. § 2145.X.D.

The Office Action violates these rules to maintain the rejections.

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The prime example of this legal error is in paragraph 10/e (page 10). Here, the Office Action contends with the fact that Delgado is not suited for horizontal operation (such as in Parker and the present claims), by specifically stating that the rejection relies “only the specific teaching of distributed liquid on a cleaning cloth has been used.” The Office Action then explains that “[t]he other features within the secondary reference are not part of the combination and thus deemed moot therefore the examiner believes the rejection is proper and thus maintained.” Office Action at 10. This approach explicitly violates the controlling case law and the M.P.E.P. guidelines.

The remainder of the rejections seem to take a similar approach of combining the discrete teaching in Delgado about using a wetted cloth while ignoring all of the other teachings in both Delgado and Parker that the combination would be unworkable and undesirable. For example, in paragraph 9/d (page 9), the Office Action addresses Applicant’s prior explanation that modifying the Parker device to wet the pad would soak the dirt, making it impossible to effectively clean with a rotating brush (the dirt would turn into mud, and the brush would sling the mud uncontrollably). In response, the Office Action simply contends that a person looking to improve Parker “could look at Delgado, which teaches of more effectively cleaning a surface by using a wetted cloth.” The Office Action simply ignores the clear problem created by the proposed combination, and in doing so fails to consider the prior art references as a whole.¹ The Office Action seems to take a similar approach in paragraph 6/a (pages 6-7), paragraph 7/b (pages 7-8) and paragraph 8/c (pages 8-9).

It is well-settled that it is legally improper to rely on discrete portions of a prior art reference, while ignoring other teachings against the proposed combination. Nevertheless, that is precisely what has happened here—explicitly in one instance and implicitly in others. In view of the foregoing (and for the reasons raised in earlier-filed responses), the Applicant respectfully requests reconsideration of the claim rejections, and allowance of the pending claims.

¹ The contention merely that one “could” look to Delgado for the missing feature also raises a question of whether there truly is a motivation to combine the references, as noted in Applicant’s earlier-filed arguments.

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CONCLUSION

For at least the foregoing reasons, the Applicant respectfully requests reconsideration of the pending rejections, and allowance of the claims. If the Examiner believes that prosecution might be advanced by discussing the application with the Applicant's counsel, in person or by telephone, the Applicant's counsel welcomes the opportunity to do so.

Respectfully submitted,
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Date: August 16, 2010

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